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| REED INTELLECTUAL PROPERTY LAW GROUP | | | FORMAN, BETTY J | |
| 1400 PAGE MILL ROAD | | | ART UNIT | |
| PALO ALTO, CA 94304-1124 | | | PAPER NUMBER | |
| | | | 1634 | |
| DATE MAILED: 10/11/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/993,353

Applicant(s)

ELLSON ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-9, 11-44, 91, 93, 103 and 110.
Claim(s) withdrawn from consideration: 109.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

BJ Forman
Primary Examiner
Art Unit: 1634

Continuation of 3. NOTE:

Claim 3 has been amended to define the device as having means for "interoperating with a computer chip on the substrate capable of performing security functions". This defining element has not previously been considered and therefore would require further search and consideration. Furthermore, the amendment potentially raises the issue of new matter. To support the amendment to Claim 3, Applicant cites pages 32-33 for a discussion of "smart card". Applicant asserts that the discloses smart card "can perform security functions under the direction of a computer. Applicant's assertion is noted. However the cited passage does not teach or describe a "smart card" nor security functions. A teaching of smart card is found at page 24. However, its use as a means of security functions is not described. For this reason, the amendments to claim 3 potentially introduce new matter.


Claims 33-36 have been amended to define the probe moieties as "distinguishable". To support the amendment, Applicant points to page 35 for a discussion of probe density. The cited passage does not describe probe density or distinguishable probes. The specification, page 11, describes distinguishable portions of the device: "The term 'discrete' is typically used herein in its ordinary sense and refers to a region of a substrate that constitutes a separate or distinct part with respect to another region of the substrate. Thus, one discrete region of a substrate, such as the interior region, is readily distinguishable from another region, such as the surface." However, neither this passage nor the entire specification teach or describe the newly claimed "distinguishable" probes. Therefore, the amendment introduces new matter. For these reasons, the amendments to claims 33-36 will not be entered.

Applicant argues the previous rejections under 112, new matter. Applicant asserts that Example 2 and passage at page 17 describing, "production runs" provides support for the claimed "removable" substrate. The cited passages have been reviewed. Page 17 does not describe a "removable substrate" or "production runs". Production runs are discussed at page 8 with regard to methods of immobilizing oligonucleotides to produce a substrate. Example 2 also describes methods of making the substrate. The instant claims are drawn to a "device.....comprising a removable substrate". Therefore, the claimed device comprises the substrate. Neither the cited passages, nor the specification teaches a device comprising a removable substrate. The rejection is maintained.

Applicant asserts that the combination of Virtanen and Hammock and/or Nova does not teach the claimed invention because they do not teach the method of operation as recited in d1-d4. The assertion is noted, however as cited in the Final Office Action, Virtanen disclose the device further comprising a fluidic device for applying target (Column 60, lines 40-46 and Column 63, lines 14-46) an apparatus for measuring interaction characteristics (Column 14, lines 53-67) and a machine whereby the functionality of the device is automated (Column 7, lines 10-59 and Column 59, line 38-Column 60, line 39) wherein their device uses computerized software for reading and controlling the device before and after assays (Column 15, lines 9-44). The instant claims are drawn to a device comprising a machine for reading information; commanding the device to apply a substance, receiving characteristics of an interaction and taking "as inputs" some information on the substrate. the instant specification defines the claimed machine at page 13, lines 1-5: "the term 'machine' encompasses computers and other devices that can perform operations in order to read information from a substrate." Virtanen specifically teaches their device is controlled using computerized software, which clearly suggests their device comprises a computer as encompassed by the claimed machine and as defined in the instant specification.

Regarding Claims 2-4, Applicant asserts that the content of the information as claimed is not taught by the cited references because the claims require use of the information content. The argument has been considered but is not found persuasive. Applicant appears to be asserting that the claims require use of specific information e.g. "identity of a customer". However, the claims are not so limiting. The claims define the device comprising machine-readable information wherein the device function by reading "some" of the information. The claims do not require use of all information whereby the structural elements of the device are defined by all information contained.

Regarding Claims 33-36, Applicant asserts that the newly claimed probes are clearly defined at page 35 of the specification. Applicant's interpretation of the claims are noted, however, for the reasons stated above, the amendments are not entered. Therefore, the arguments are deemed moot.


BJ FORMAN, PH.D.
PRIMARY EXAMINER